

Application No.: 10/766,366  
Amendment and Response dated October 27, 2006  
Reply to Office Action of June 27, 2006  
Docket No.: A0003767-030-EJF (1321-13 DIV)  
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## **REMARKS**

### **Status of Claims**

Claims 1, 3, 19 and 21-33 are currently pending in this application. Claims 28-30 are withdrawn as the result of a previous restriction requirement. Claims 1, 7 and 23 have been amended and claims 2 and 20 have been canceled. New claim 33 has been added.

### **Applicants' Response to the Information Disclosure Statement**

The Examiner has objected to the information disclosure statement filed June 14, 2004 for failure to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. (Office action of 06/27/2006, at page 3). Please find enclosed herewith copies of each foreign document. Legible copies of each foreign document were previously submitted in the parent, U.S. Application No. 10/207,726. Therefore the information disclosure statement filed on June 14, 2004 is believed to be in compliance with 37 CFR 1.98(a)(2). Consideration of the references is respectfully requested.

### **Applicants' Response to the Objection**

Claim 7 was objected to for a spelling informality. The term "eucalyptol" was inadvertently misspelled. The error has been corrected and withdrawal of this objection is respectfully requested.

**Applicants' Response to Rejection Under 35 USC § 102 over Lion Corp**

Claims 1-7, 14-19, 21, 23-25, 27 and 31-32 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Japanese Patent No. 07-187973 (hereinafter "Lion Corp").

Applicants respectfully request reconsideration on the basis that Lion Corp fails to disclose each and every element of Applicants' claims, as amended herein.

The Examiner asserts that:

Lion Corp teaches liquid oral compositions comprising hinokitiol and other essential oils. The compositions are used for mouthwashes but also may be used for water toothbrushing and mouth deodorant. Hinokitiol may be incorporated into the compositions at levels ranging from 0.00005 to 0.1%, encompassing claims 3-5. Other components of the compositions include enzymes, fluorides, chlorhexidine salts, epsilon-aminocaproic acid and glycyrrhizin salts. The compositions also comprise other perfume articles such as antehole, eugenol, methyl salicylate, linalool, menthol and limonene. Menthol comprise 0.005 to 1% of the compositions, encompassing claims 17-19. Water is present from 50 to 95%, which is an oral carrier encompassing the instant claims. **Ethanol comprises less than 3% of the composition**, encompassing claims 23-25. Methyl salicylate was incorporated into a non-hinokitiol comprising example at 0.05%. It can be concluded methyl salicylate may be incorporated into compositions comprising hinokitiol in this amount, encompassing claims 14-16. The reference anticipates the claims insofar as it teaches compositions comprising hinokitiol, an essential oil and an oral carrier.

(Office Action of 6/27/06, at page 4) (citations omitted) (emphasis added).

Claim 1 has been further amended to define the invention. In particular, claim 1 has been amended to require ethanol in amounts of about 20% to about 30% by weight of the composition. This amendment is supported by disclosure appearing at page 22, line 13 of the

application as originally filed. Lion Corp does not disclose, teach or suggest using ethanol in the specified amounts.

Moreover, Lion Corp actually teaches away from using ethanol present in amounts of about 20% to about 30% by weight of the composition, specifically stating that “[t]his composition for oral cavity is obtained by blending a liquid composition for oral cavity not containing ethanol or containing  $\leq 3$ wt.% of ethanol.” (Lion Corp Abstract). In accordance therewith, Lion Corp actually teaches away from including high amounts of ethanol in its compositions, particularly 20-30% by weight, as recited in Applicants’ amended claim 1. *see Tec Air, Inc. v. Denso Mfg. Michigan, Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999), *citing In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant or if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.”). In view of such statement, any reference showing ethanol present in the amount of about 20% to about 30% by weight of the composition would not be properly combinable with Lion Corp.

Therefore Applicants respectfully submit that amended claim 1, and thus any claims which depend therefrom, are patentable over Lion Corp. Withdrawal of this rejection is respectfully requested.

**Applicants' Response to Rejection under 35 USC §102 over Sugano**

Claims 1-10, 14-19, 21, 23-25, 27 and 31-32 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Japanese Patent No. 07-187977 (hereinafter "Sugano").

Applicants respectfully request reconsideration on the basis that Sugano fails to disclose each and every element of Applicants' claims, as amended herein.

The Examiner contends:

Sugano et al, teach oral compositions comprising hinokitiol. Hinokitiol may be incorporated into the compositions at concentrations ranging from 0.0001 to 0.1%. The compositions comprise essential oils such as anethole, eugenol, methyl salicylate, linalool, menthol and limonene. Thyme oil may also be used in the compositions, in which thymol is one of its components and makes up about 49% of the oil. The thyme oil was incorporated into one of the compositions in conjunction with hinokitiol at a concentration of 0.05% (0.0245% thymol), encompassing claims 8-10. **Ethanol is also in the compositions comprising about 3.5% in one example.** Water was disclosed in all examples. The reference anticipates the claims insofar as it teaches compositions comprising hinokitiol, an essential oil and an oral carrier.

(Office Action of 6/27/06, at page 5) (citations omitted) (emphasis added).

As stated above, claim 1 has been amended to require ethanol in amounts of about 20% to about 30% by weight of the composition. Sugano does not disclose, teach or suggest using ethanol in the specified amounts. Moreover, Sugano does not disclose, teach or suggest the combination of hinokitiol, an essential oil and ethanol.

The only recitation of ethanol in Sugano is found in Example 7. Specifically, Example 7 includes:

[Example 7] Liquefied toothbrushing Glycerol (85%) 34.0% Propylene glycol 5.0 Sodium polyacrylate 3.5 Sodium lauryl sulfate 1.0 Ethanol 3.5 Dextranase 0.15 HIKICHI oar 0.002 L-menthol 5.0 Saccharin sodium 0.08 Cineol 0.5 Purified water \*\* Total 100.0%.

(Sugano, see Example 7 at paragraph [0037]).

As seen above, the only reference to ethanol in Sugano uses 3.5% by weight of the composition. Moreover, this example does not include hinokitiol. In view thereof, there is absolutely no teaching or suggestion in Sugano to use the much higher amounts of ethanol, i.e. about 20-30% by weight of the composition, recited in Applicants' amended claims. Nor is there any suggestion to use such high amounts of ethanol in combination with hinokitiol and at least one essential oil. Nor is there any suggestion or motivation in Sugano to alter the ethanol content as such. *See In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), *citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference."). Therefore, Sugano does not teach or fairly suggest Applicants' amended claims. Therefore Applicants respectfully submit that amended claim 1, and thus any claims which depend therefrom, are patentable over Sugano. Withdrawal of this rejection is respectfully requested.

**Applicants' Response to Rejection under 35 USC §103 over Lion Corp in view of Fand**

Claims 1-19, 21-27 and 31-32 are rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Lion Corp in view of U.S. Patent No. 3,164,524 to Fand et al. (hereinafter "Fand"). Applicants respectfully request reconsideration on the basis that the combination of references fails to render the claims obvious, as amended herein.

The Examiner acknowledges that Lion Corp fails to disclose or, "teach thymol and eucalyptol, and the specific weight percent for methyl salicylate." (Office Action of 6/27/06, at page 6). The Examiner further acknowledges that Fand does not teach using hinokitiol. (Office Action of 6/27/06, at page 7). The Examiner alleges, however, that Fand teaches "oral antiseptic compositions comprising menthol, thymol, eucalyptol and methyl salicylate." (Office Action of 6/27/06, at page 6). Accordingly, the Examiner contends that it would have been obvious to one of ordinary skill in the art to use the amounts of the essential oils in a composition comprising hinokitiol to arrive at Applicants' invention recited at claims 1-19, 21-27 and 31-32.

As discussed above, Lion Corp fails to disclose, teach or suggest using ethanol present in amounts of about 20% to about 30% by weight of the composition. Fand was merely cited for its disclosure of essential oils. Nowhere in Fand are compositions comprising hinokitiol, an essential oil and the specific amounts of ethanol disclosed, taught or suggested. Therefore, Fand fails to cure the deficiencies of Lion Corp in this regard. Applicants respectfully request reconsideration of the Section 103 rejection based on this combination.

**Applicants' Response to Rejection under 35 USC §103 over Lion Corp in view of Talwar**

Claims 1-19, 21-27 and 31-32 are rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Lion Corp in view of U.S. Patent No. 4,945,087 to Talwar et al. (hereinafter "Talwar"). Applicants respectfully request reconsideration on the basis that the combination of references fails to render the claims obvious, as amended herein.

The Examiner acknowledges that Lion Corp fails to disclose or, "teach thymol and eucalyptol, and the specific weight percent for methyl salicylate." (Office Action of 6/27/06, at page 6). The Examiner further acknowledges that Talwar does not teach using hinokitiol. (Office Action of 6/27/06, at page 7). The Examiner alleges, however, that Talwar teaches "oral compositions comprising thymol and other essential oils." (Office Action of 6/27/06, at page 7). According to the Examiner, therefore, it would have been obvious to one of ordinary skill in the art to take the oral composition comprising hinokitiol and use the weight percents for the essential oils of Talwar to arrive at Applicants' invention recited at claims 1-19, 21-27 and 31-32.

As discussed above, Lion Corp fails to disclose, teach or suggest fails to disclose, teach or suggest using ethanol present in amounts of about 20% to about 30% by weight of the composition. Talwar was merely cited for its disclosure of essential oils. Nowhere in Talwar are compositions comprising hinokitiol, an essential oil and the specific amounts of ethanol disclosed, taught or suggested. Therefore, Talwar fails to cure the deficiencies of Lion Corp in

this regard. Applicants respectfully request reconsideration of the Section 103 rejection based on this combination.

It should be noted that Applicants have incorporated the phrase "an oral care effective amount" to claim 1 to provide antecedent basis for the dependent claims.

It should also be noted that Applicants have added new independent claim 33 which resembles original claim 1, but has been amended to include the specific combination of essential oils in specifically recited amounts: thymol, eucalyptol, menthol, and methyl salicylate. None of the art of record teaches or suggests such recitation. Therefore, it is respectfully submitted that new claim 33 provides an additional basis of patentability.

Having responded in full to the present Office Action, it is respectfully submitted that the application is in condition for allowance. Favorable action thereon is respectfully solicited.

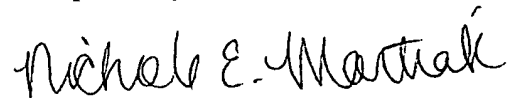
The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.



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Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Respectfully submitted,

A handwritten signature in cursive script that reads "Nichole E. Martiak".

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